

**REMARKS**

The provisional election of Group I, claims 1-35, made by James Krueger without traverse during a telephone conversation with the Examiner on February 16, 2010 is affirmed. Claims 36-51 are withdrawn as being drawn to a non-elected invention. Therefore, claims 1-35 are presently under examination.

**Rejections Under 35 U.S.C. § 112**

Claims 1-35 were rejected under 35 U.S.C. § 112, second paragraph.

Claim 1 is rejected as allegedly having insufficient antecedent basis for the limitation "the inlet and outlet of the brew head." MPEP 2173.05(c) states:

If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. *Energizer Holdings Inc. v. Int'l Trade Comm'n*, 435 F.3d 1366, 77 USPQ2d 1625 (Fed. Cir. 2006)(holding that "anode gel" provided by implication the antecedent basis for "zinc anode"); *Ex parte Porter*, 25 USPQ2d 1144, 1145 (Bd. Pat. App. & Inter. 1992) ("controlled stream of fluid" provided reasonable antecedent basis for "the controlled fluid").

Prior to the phrase "the inlet and outlet of the brew head," the claim recites "the brew head comprising an upwardly directed inlet for supplying water to the brew head, a downwardly directed outlet for outflow of beverage produced by the machine" and contains no other intervening introduction of inlet or outlet elements relating to the brew head. Therefore, antecedent basis is indeed provided for the phrase "the inlet and outlet of the brew head."

Claim 18 is rejected as indefinite for the use of the term "sufficient" in the phrase "said closure mechanism squeezes the upper and lower parts of the insert together with sufficient force for the sealing means to seal together the upper and lower parts" as recited in claim 18. The scope of the term "sufficient force" is clearly defined by the claim itself: "for the sealing means to seal together the upper and lower parts." In addition, the scope of the term "sufficient force" is ascertainable based on the disclosure of the specification, e.g., page 32, line 5 to page 34, line 5 of the Specification as filed.

Claim 20 is rejected as indefinite for the use of the term "the upper part" as the Examiner asserts that it is unclear if "the upper part" refers to "the upper part of the insert." Similar to the rejection to claim 1, it is asserted that sufficient antecedent basis is provided. Particularly, claim 1 recites "...the insert comprising an upper part..." and no other intervening introduction of an upper part in relation to any other structure is provided in any of claims 1-19. Therefore, the introduction of "an upper part" provides direct antecedent basis for the term "the upper part."

Claim 30 is rejected as indefinite for the use of the term "generally" in the phrase "generally in an inward direction" as recited in claim 30. The term "generally" is an accepted modifier allowing for some variation from the standard, *e.g.*, *Anchor Wall Sys. v. Rockwood Retaining Walls, Inc.*, 340 F.3d 1298, 1311 (Fed. Cir. 2003), (generally parallel would envision some amount of deviation from exactly parallel). It is clear that the term "generally in an inward direction from the inlet to the outlet" means that flow will move from the inlet to the outlet and that there may be some deviation from the flow progressing directly from the inlet to the outlet. Further, support for the phrase can be found at least at page 44, lines 7-11 and Figures 22 and 23 of the Specification as filed.

For at least the above reasons, claims 1-35 are not indefinite under 35 U.S.C. § 112.

### **Rejections Under 35 U.S.C. § 103**

Claims 1-25 stand rejected under 35 U.S.C. § 103(a) as obvious over Burrows et al. US 6,968,775 B2 ("Burrows"), and in view of Cai US 7,032,503 B2 ("Cai").

With regard to claim 1, the applied references fail to disclose or suggest an insert for use in a beverage preparation machine of a type comprising a brew head "such that, in use, water from the inlet of the brew head passes upwardly through the inlet of the insert into the brewing volume and such that beverage produced from the water and the quantity of beverage ingredients passes downwardly through the outlet of the insert" as recited in claim 1.

Instead, Burrows discloses that the inlet to the inner portion of the brew basket 12 be provided in the form of hollow ribs 72 formed in the brew basket side walls 68. These hollow ribs 72 are disclosed as having closed upper ends and being provided with multiple jet ports 14 “positioned and aimed for jetting water streams generally tangentially in a common swirling direction...into the brew basket interior” (Burrows, Col. 5, lines 44-64). Such an arrangement is provided to generate centrifugal action against the brew basket side wall. (Burrows, Col. 6, lines 54-57). Therefore, instead of the water being introduced from the bottom of the brew volume upwardly into the brew chamber through an inlet formed in the bottom of the insert, as claimed, the water is introduced at various levels along the sidewall and above the bottom of the brew basket in Burrows.

Cai does not cure the failing of Burrows. Similar to Burrows, Cai discloses that water is to be introduced from above the bottom of the insert. Particularly, Cai discloses that water is introduced from a brew head 35 downwardly into a brew basket 32 through a hygiene device 10. (Cai, Col. 2, line 54 – Col. 3, line 4).

Because neither reference discloses or suggests an insert such that “water from the inlet of the brew head passes upwardly through the inlet of the insert into the brew volume” as recited in claim 1, their proposed combination will not result in the insert of claim 1. Thus, the Office action has failed to establish a *prima facie* case of obviousness.

With further regard to claim 1, the applied references fail to disclose or suggest an insert for use in a beverage preparation machine of a type comprising a brew head “such that beverage produced from the water and the quantity of beverage ingredients passes downwardly through the outlet of the insert” as recited in claim 1.

The Office action, pp. 4-5, alleges that this element is found in Burrows. However, this is not the case. Burrows discloses that its brew basket 12 is to be provided with brew basket side walls 68, “a portion of which is defined by one or more mesh or mesh-like filter elements 78. Such filter elements 78 are supported by the brew basket 12 in slightly spaced relation to the adjacent divider wall 36 to define a flow pathway” (Burrows, Col. 6,

lines 55-59). Therefore, the flow path of the beverage of Burrows is in a lateral direction through the filter elements 78 of the brew basket 12, not downward through an outlet as presently claimed. Accordingly, for this additional reason, the Office action has failed to establish a *prima facie* case of obviousness.

For at least the above discussed reasons, it is asserted that the applied references fail to disclose or suggest claim 1 and thereby request reconsideration and allowance of claim 1. Similarly, claims 2-35, dependent from claim 1, are allowable as well for the reasons discussed above.

With regard to claim 4, the applied references fail to disclose or suggest an insert wherein "the quantity of beverage ingredients loaded in use into the insert are contained in a container comprising filtering means" as recited in claim 4.

The Office Action alleges that Burrows discloses the claimed container because Burrows discloses a brew basket 12 on which mesh-like filter elements 78 are provided on portions of the side wall. However, the Office Action is now applying the brew basket 12 against this claim as both the insert and the container comprising filtering elements. However, as claimed, these are two separate and distinct elements with the container being loaded into the insert. The Office Action fails to describe how this is disclosed or suggested by Burrows.

Similarly with claims 5-9, the Office Action fails to identify how Burrows discloses both a receptacle and a container. With specific regard to claim 7, the Office Action alleges that Burrows discloses "the container is a filter bag" as recited in claim 7. The Office Action states "Fig. 7, the portion of 78 is shaped like a bag" (Office Action, page 6). This statement is completely unfounded. There is no such claimed bag disclosed or suggested in Burrows.

Claims 26-35 stand rejected under 35 U.S.C. § 103(a) as obvious over Burrows, and in view of Halliday et al. US 2004/0197444 A1 ("Halliday"). In view of the above discussion of Burrows and Cai as applied to claim 1, it is respectfully asserted that claims 26-35, dependent therefrom, are allowable as well.

Application No. 10/589,459  
AMENDMENT dated June 16, 2010  
Reply to Office Action of March 22, 2010

#### CONCLUSION

For the reasons discussed above reconsideration and allowance of claims 1-35 are respectfully requested. The Examiner is invited to contact the undersigned attorney to expedite prosecution.

The Commissioner is hereby authorized to charge any additional fees which may be required with respect to this communication, or credit any overpayment, to Deposit Account No. 06-1135.

Respectfully submitted,  
FITCH, EVEN, TABIN & FLANNERY

Dated: June 16, 2010

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